

THIS DECISION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

Paper No. 12
TJQ
Mailed:5/5/04

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re 3522806 Canada Inc.

Serial No. 76394362

Howard N. Aronson, Nancy Dwyer Chapman and Leah E.
Greenspan of Lackenbach Seigel for applicant.

Ira Goodsaid, Trademark Examining Attorney, Law Office 115
(Tomas Vlcek, Managing Attorney).

Before Seeherman, Quinn and Drost, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed by 3522806 Canada Inc. to
register the mark shown below

ulalona

for "entertainment in the nature of theater productions."¹

The trademark examining attorney refused registration under Sections 1, 2 and 45 of the Trademark Act on the ground that the mark is the title of a single creative work and, accordingly, is unregistrable.

When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs. Although applicant initially requested an oral hearing, the request subsequently was withdrawn.

Applicant asserts, in urging that the refusal be reversed, that the mark "is used to designate each incarnation of performance in conjunction with other distinct factors of each performance such as venue, length of performance, medium, and content, thereby comprising the unifying identifying brand name for each distinct performance among the series." (Brief, p. 2). Applicant goes on to state that the mark "identifies a series of evolving, and each different, entertainment performances emanating from a single identifiable source, rather than merely the re-showing of a single, identical performance."

¹ Application Serial No. 76394362, filed April 10, 2002, alleging first use anywhere and first use in commerce on July 21, 1999. The application includes a statement that "'Ulalena' is a Hawaiian word that is the name for a wind that blows on the island of Maui and is also the name for rains that fall on the island of Maui."

(Brief, p. 3). As applicant's schedule shows, the show has been staged as an entire production in a conventional theater and, in addition, elsewhere as a production for a radio station, an awards ceremony, and sporting events. According to applicant, "all are distinct in the types of scenes, music, spoken word, choreography, stage action, lighting and set design they contain" and that "each performance is separate, different and being re-created and re-staged, based on the venue and medium where it is anticipated to be performed." (Brief, p. 3). Applicant points out that "the performances at a golf tournament or at a National Geographic Society lecture, for example, are not identical to the performance given at Maui Myth & Magic Theatre, nor are they of ninety minutes' duration." The examining attorney, applicant argues, has "focused solely on one of Applicant's series of performances but has ignored the evidence submitted of other companion performances in the overall series of ULALENA theatrical entertainments." (Brief, p. 4). Further, applicant contends, while the mark is used to designate a series of various theatrical performances, "it is coupled with information that recites distinguishing factors of each performance, such as where and when the particular performance is to take place." (Brief, p. 6). In support

of its position, applicant submitted a schedule of the seven off-site performances of its production since the first one in August, 2001.

The examining attorney maintains that the mark sought to be registered is the title of a single theatrical production. The examining attorney asserts that while the cast, venue and show length may vary, these facts do not alter the fact that the mark identifies a particular show about Hawaiian history, legends and music. This case, according to the examining attorney, falls squarely under the holding of the decision in *In re Posthuma*, 45 USPQ2d 2011 (TTAB 1998). In support of the refusal, the examining attorney submitted materials retrieved from the Internet regarding applicant's theatrical show performed under the name "Ulalena."

We find that the title of applicant's live theater production, ULALENA, is not a registrable service mark for entertainment services in the nature of theater productions. The specimen of record, together with the Internet evidence submitted by the examining attorney, make it clear that ULALENA is the title of applicant's theater production.

The present case is similar to the situation in *In re Posthuma*, supra. In that case, the Board held that the

proposed mark PHANTASM, as the title of a live theater production, was unregistrable for entertainment services in the nature of live theater production. In analyzing the issue, the Board viewed the language of *In re Cooper*, 254 F.2d 611, 117 USPQ 396 (CCPA 1958), regarding the unregistrability of a book title, to be equally applicable to the title of a live theater production.

In the case of *In re Posthuma*, supra at 2013-14, the Board stated the following:

The gist of one of applicant's main arguments is that plays are different from books because of the theater's live component, with each performance differing due to the abilities of the cast, stage crew, set designers, musicians and the like. Applicant also points out that its production has evolved through the years by the addition of new elements or the rearrangement of existing ones. We are not persuaded by these arguments. We recognize that the nature of live theater dictates that changes will occur from time to time in a stage production. Nonetheless, as appears to be the case with applicant's production, the essential story of the play remains, by and large, intact. Whatever the changes made to this live theater production, it still remains a single work. Thus, these often subtle changes do not transform the show into a "series" of shows, thereby turning the unregistrable title into a registrable service mark.

Applicant's main arguments herein are very similar to the ones found unpersuasive in the earlier decision.

Applicant's main brief contains no discussion of *In re Posthuma*, but applicant, in the final paragraph of its reply brief (pp. 2-3), attempts to distinguish that case from the present one as follows:

Only one incarnation of the ULALENA series of performances occurs in a theater; only one incarnation of ULALENA takes the form of a full-fledged play. Applicant has submitted incontrovertible evidence of a family of ULALENA performances, each of which must necessarily vary greatly in their types of scenes, music, spoken word, choreography, stage action, lighting and set design, given the variant mediums and venues. Each of those eight (8) submitted forms of performance are not merely minor variations of a full-length play with all the bells and whistles that accompany a performance in a new state-of-the-art theater, rather they are distinct and disparate forms of performances.

The record is devoid of any evidence showing that the proposed mark is being used for a series of different productions. In point of fact, other than counsel's assertions, there is no evidence showing that applicant's seven "off-site performances" shown on its schedule differ in any respect from the original production. In any event, that there may be variations of the production in terms of

length of show, music, staging, etc. to better suit particular venues and audiences is not dispositive. As pointed out by the examining attorney, such things as the length of a show and its staging are varied due to the many vagaries inherent in live theater (including road shows of a production).² In the present case, there apparently are different versions of the production because of the constraints caused by different venues where it may be shown, or by different time constraints. The simple fact remains that ULALENA is the title of a single theater production about Hawaiian cultures, traditions and history. Although the venue or length of performance may vary, each production would be regarded by consumers as the same.

² We agree with the following assessment made by the examining attorney (Brief, pp. 5-6):

The applicant posits that ULALENA is a service mark because its content varies somewhat, with different performers in different venues performing the play for 75 to 90 minutes. Just because circumstances dictate that the show be briefer sometimes, this does not make the name of the show function as a service mark. Since most venues differ, any show must adapt to its setting. The Maui Myth & Magic Theatre (MM&MT) is probably ideally suited for staging the ULALENA show. Other places may lack unique features of the MM&MT, and therefore mandate that the play be modified to suit its surroundings. Thus, the decision to shorten a show by deleting certain acts or scenes to suit particular audiences or locales may be made to accommodate such circumstances.

Ser No. 76394362

We conclude that ULALENA (stylized), as the title of a single live theater production, is unregistable because it does not function as a service mark.

Decision: The refusal to register is affirmed.